

the unusual timing of the requirement, *i.e.*, *after* a first Office Action on the merits. *See* non-Final Office Action of September 11, 2006. The Examiner acknowledged that a restriction requirement should more properly have issued from the Office prior to the first Office Action on the merits. During the interview, Applicants advanced additional arguments traversing the restriction, and these are presented and further developed below.

*Applicants' Remarks in Traversal of the Restriction Requirement*

The Office has required restriction between Group I: claims 1, 3, 4, 6, 11-19, drawn to the blunt dissector of Figures 1, 2, and 2a through 2c; and Group II: claims 7, 8, 9, drawn to the attachment to a surgical instrument of Figures 3 and 4. The Office asserts that the subject matter claimed in Groups I and II are independent or distinct inventions because they have materially different designs and different classifications, and as a result, the Office submits that "there would be a serious burden on the examiner if restriction is not required..."

Applicants respectfully highlight that the law does not always require restriction between two or more claimed inventions. As provided by statute, "If two or more independent and distinct inventions are claimed in one application, the Director may require the application be restricted to one of the inventions." 35 U.S.C. 121 (emphasis added). Applicants acknowledge that in some instances restriction may make the patent examining process more efficient, in particular, when the search of two or more inventions would present an undue burden on the Office. However, "[i]f the search and examination of all the claims in an application can be made without serious burden, the examiner *must* examine them on the merits, *even though they include claims to independent or distinct inventions.*" MPEP 803 (emphasis added). Hence, the current state of patent law requires simultaneous examination of claims to independent or distinct inventions if their search does not present an undue burden on the Office.

In view of the foregoing restriction standard, Applicants respectfully request that the Examiner withdraw the outstanding restriction requirement and examine all the claims for the reasons that follow. Applicants assert that a search of the subject matter of both Groups I and II would not present an undue burden on the Office, namely because the claims of Groups I and II have already been searched and examined together, apparently without any undue burden on the

Office. The subject matter of Groups I and II were the basis of the first Office Action on the merits issued on September 11, 2006. By definition, a first Office Action on the merits cannot issue without a search and examination of all claims not currently withdrawn. *See* 37 C.F.R. 1.104(b): “The examiner’s action will be complete as to all matters...” (emphasis added); *see also* MPEP 707.07. Examination of applications “piecemeal” and “partial searches” of claimed subject matter are improper. *See* MPEP 707.07(g). Hence, the subject matter of both Groups I and II has already been searched and examined by the Office without undue burden. Moreover, Applicants further note that in their response to the first Office Action on the merits, Applicants did not substantively amend the pending claims, so Applicants’ actions could not have rendered the outstanding restriction requirement necessary.

Furthermore, Applicants assert that a search of the claims of Group II along with those of the elected Group I would not unduly burden the Office because the claims of Group II have been previously searched, examined, and allowed by another Examiner. Pursuant to MPEP 704.01 under the heading “**PREVIOUS EXAMINER’S SEARCH**”:

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action ... In general the second examiner should not take an entirely new approach to the application ... or make a new search in the mere hope of finding something.

(emphasis added). The claims of Group II were examined previously and allowed under a Notice of Allowance mailed July 28, 2004. The claims were then withdrawn from issuance with the Petition Under 37 C.F.R. 1.313(C) filed January 14, 2005. The claims of Group II have not been amended since then, and as such, are in the same form as when they were previously searched and examined. As a search of the claims of Group II has already been performed by the Office and no additional search is required per MPEP 704.01, Applicants assert there can be no additional burden on the Office in searching the claims of both Groups I and II versus searching the claims of Group I alone.

Accordingly, Applicants assert that since a search and examination of the subject matter of both Groups I and II was already performed at least once (and a second time in the case of the claims of Group II), there is no additional burden on the Office in rejoining these groups. As

indicated by established restriction practice discussed above, the Office is required to examine the present claims in their entirety. Accordingly, Applicants respectfully request reconsideration and withdrawal of the outstanding restriction requirement.

If the Office maintains the present restriction requirement on the grounds that a search of all the pending claims presents an undue burden on the Examiner, Applicants request clarification as to how searches already performed can present an undue burden, outside of the possibility that the previous searches were in some way erroneous or defective and therefore in need of repetition.

Applicants believe no fee other than that indicated above for the extension of time is due with this response. However, if an additional fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P01-011 from which the undersigned is authorized to draw.

Dated: April 6, 2007

Respectfully submitted,

By 

Carl A. Morales, Ph.D.

Registration No.: 57,415  
FISH & NEAVE IP GROUP,  
ROPES & GRAY LLP  
One International Place  
Boston, Massachusetts 02110-2624  
(617) 951-7000  
(617) 951-7050 (Fax)  
Attorneys/Agents For Applicants